

REMARKS

This amendment is submitted in response to the Examiner's Action dated April 25, 2003. Applicant has not amended the claims. However, Applicant has amended the specification to clarify features of the invention, which Examiner suggests were not sufficiently explained. No new matter has been added, and the amendments (and arguments below) overcome the §112 rejection of the claims. Applicant respectfully requests entry of the amendments to the specification.

CLAIMS REJECTIONS UNDER 35 U.S.C. § 112

At paragraph 2 of the present Office Action, claims 1-21 are rejected under 35 U.S.C. §112. Specifically, Examiner states that Applicant does not provide any details about the electronic format of the electronic publications. Examiner further expand his objection by suggesting that a person of ordinary skill in the art would ask the following questions:

- (1) How is a cookie packaged with the issue?; and
- (2) How does the client detect that an issue has been opened?

Applicant respectfully disagrees with Examiner's suggestion that Applicant did not have full possession of the claimed invention because Applicant did not sufficiently describe features relevant for practicing the invention. Applicant also respectfully disagrees with Examiner's characterization of questions that would be raised by one of ordinary skill in the art.

First, Applicant's invention clearly describes what is an electronic publication in the background section of the application. On page 2, lines 7-11, Applicant discusses electronic format of THE WALL STREET JOURNAL that is currently being delivered. Since such electronic publications were already being delivered in electronic format at the time of Applicant's invention, Applicant does not need to spell out the specific "electronic format" for one skilled in the art to be able to practice the invention. Notably, however, at page 17, line 4-21 Applicant states that the issue is viewed utilizing a web browser. Applicant further refers to the issue as a web page. At line 15 of page 2, Applicant indicates that the electronic format may include multimedia content such as audio and animation. The format required for delivery of a publication via email that opens up as a web page within a browser would have been clear to one

skilled in the art. Most of these techniques were available and known even in the context of push techniques for delivering electronic content (via email, etc.) to subscribers (see page 4). Since Examiner has taken issue with the specification not containing such references, Applicant has amended the specification to include sentences taken from throughout the application that would suggest extending known formats for delivering the electronic publication.

With respect to the first question, Applicant recognizes that Examiner may have been confused by the use of the term “packages” to describe the associating and transmission of a cookie along with the web page. Applicant has replaced the term with “associates”. Associating (packaging) a cookie with a downloaded web page (or html document) is well known in the art and any person with ordinary skill in the computer arts would comprehend how a cookie could be associated with a publication (composed as a web page or html document) that is transmitted via the Internet to a customer computer system in electronic format. The content of page 6, lines 12-18 describes the push engine transmitting an HTTP cookie along with the issue and using a cookie response from the subscriber to know when the issue has been opened. This content has been added to the specification where utilization of cookies are discussed.

Applicant further points out that the questions raised about utilization of a cookie, covers only one of two implementations of Applicant’s invention by which the “open” status of the received issue is monitored and messaged to the server. The second implementation, which utilizes a status request and status response, and claims directed to that implementation should not be subject to the §112 rejection.

Turning now to the second question, detecting the opening of a received email document is a feature available with most email engines on client systems. On page 16, lines 22- page 17, line 3, Applicant carefully outlines the utilization of a client program (e.g., email engine) that carries out the functional features of: receiving the issue; saving the issue; determining whether the saved copy has been opened; and transmitting a status update to the server. Again, even one with limited skill in the computer arts would be aware that it is very possible to track when a received email is opened on a client system. Most client system’s (i.e., engines) track “open” status of incoming emails and changes the display of the received email when it is opened. Since

the capability of tracking when an email is opened is available, Applicant simply harnessed this functionality and extended it to the specific implementation provided by Applicant's invention.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103(a)

At paragraph 4 of the Office Action, Claims 1-3, 7-10 and 14-17 are rejected under 35 U.S.C. § 103(a), as being unpatentable over Griebenow, et al. (U.S. Patent No. 5,850,520).

At paragraph 12 of the Office Action, Claims 5-6, 12-13 and 19-21 are rejected under 35 U.S.C. § 103(a), as being unpatentable over Griebenow, et al. (U.S. Patent No. 5,850,520) in view of Hoyle (U.S. Patent No. 6,141,010).

On page 5, lines 15-21 of the specification, Applicant clearly describes the problem solved by the invention as "overloading a subscriber with unwanted issues of a publication." Applicant's claimed invention solves this problem by allowing each new issue of a publication to be transmitted to the subscribed ONLY AFTER a previous issue has been opened. This feature is clearly recited in each independent claim.

Griebenow (and the combination of Griebenow and Hoyle) does not render Applicant's invention unpatentable because Griebenow does not suggest this key feature of Applicant's invention. Examiner initially appears to have recognized that Griebenow does not teach or suggest this feature at the end of numbered paragraph 5 of the Action. Examiner, then points to col. 10, lines 30-48 of Griebenow and completely mischaracterizes what is provided by that section.

Having carefully read Griebenow and that specific section of Griebenow, Applicant asserts that col. 10., lines 30-48 is completely devoid of any reference or suggestion of this feature of Applicant's claimed invention. Rather, that section discusses the manner of displaying advertising on pages of the electronic publication, which includes a timed display of the advertisement (e.g., every 15 minutes that the user reads the application). The section further states that "[t]he advertising timing carries over to the next time... prevent a consumer from trying to avoid viewing advertising." Even col. 9, lines 5-11 only describes customizing a publication and/or the advertisement within a publication. Nowhere in Griebenow is there any

reference or suggestion of preventing a push of a next issue of a publication until after the first (or previous) issue has been read.

Hoyle also fails to teach or suggest this feature. Further, the cited section of Hoyle (col. 17, line 27-45) relied upon by Examiner as suggesting dependent claim features does not teach specific use of a cookie to provide status message about whether an issue has been opened on a client system. That section of Hoyle describes including a user ID in a cookie placed on the user's computer, where the user ID is "stored along with demographic data to identify the user for the purpose of demographically targeting advertising to that user."

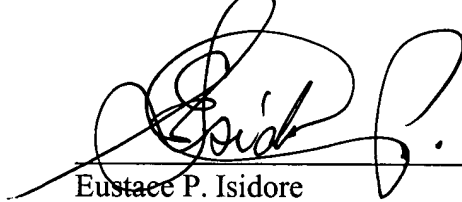
It is clear that key features of Applicant's invention are neither taught nor suggested by any of the above references or combination of references. For these reasons, one skilled in the art would not find Applicants invention obvious in light of the references and combinations thereof. The above claims are therefore allowable.

CONCLUSION

Applicant has diligently responded to the Office Action by amending the specification to overcome the §112 rejections and explaining the deficiencies in Examiner's §112 rejection. Applicant has further explained why the claims are not obvious over the references recited alone or in combination. The amendments to the specification and arguments overcome the §112 and §103 rejections, and Applicant, therefore, respectfully requests reconsideration of the rejections and issuance of a Notice of Allowance for all claims now pending.

Applicant respectfully requests the Examiner contact the undersigned attorney of record at (512) 542-2100 if such would further or expedite the prosecution of the present Application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'E. Isidore', is written over a horizontal line.

Eustace P. Isidore

Registered with Limited Recognition (see attached)

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